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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/505,632	02/16/2000	Michael C. Scroggie	CAT/34-SCRO-CCP	5917

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NEIFELD IP LAW, PC
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ARLINGTON, VA 22202

EXAMINER

ROBINSON BOYCE, AKIBA K

ART UNIT PAPER NUMBER

3623

DATE MAILED: 10/21/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/505,632

Applicant(s)

SCROGGIE ET AL.

Examiner

Akiba K Robinson-Boyce

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 02 July 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 24-31, 36-43 and 48-51 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 24-31, 36-43 and 48-51 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input checked="" type="checkbox"/> Other: <u>Advisory Action</u> . |

DETAILED ACTION

Status of Claims

1. The following office action is in response to the appeal brief filed 7/2/04. Claims 50 and 51 have been amended as described in the amendment also filed 7/2/04. The finality of the previous office action has been withdrawn and the amendment filed 7/2/04 has been entered. Claims 24-31, 36-43, and 48-51 are pending in this application, and have been examined on the merits. The previous rejection has been withdrawn, and the following reflects the claims as amended.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claims 50 and 51 recites the limitation "transmission from a consumer to a retailer website", "transmission from the retailer website to a remote website" in claim 50 and "means for transmitting from a consumer to a retailer website", "means for transmitting from the retailer website to a remote website", in claim 51. There is insufficient antecedent basis for this limitation in the claim.

There is no indication as to what is being "transmitted". Correction is required.

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

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(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371© of this title before the invention thereof by the applicant for patent.

5. Claims 24, 25, 26, 28, 30, 36, 37, 38, 40, 42, 48, 48, 49, 50 and 51 are rejected under 35 U.S.C. 102(e) as being anticipated by Perkowski (US Patent 5,950,173).

As per claim 28, 40, Perkowski discloses:
transmitting from a consumer computer over the internet to a Web site of a retailer a request for manufacturer incentives to purchase one of a product and a service offered by a manufacturer/means for transmitting from a consumer computer over the internet to a Web site of a retailer a request for manufacturer incentives to purchase one of a product and a service offered by a manufacture/transmission from the a consumer to a retailer website, (Col. 11, line 64-Col. 12, line 5, shows a plurality of User (or Client) Computers being connected to the Internet and available to consumers, Manufacturers, and Retailers, w/ Col. 15, lines 1-4, lines 19-27, shows that a consumer makes a request at a client subsystem that is physically hosted at the retailer by way of a three-field browser framework);

in response to receipt of said request at said Web site of said retailer,
transmitting said request from said Web site of said retailer over the Internet to a remote Web site/means for transmitting said request from said Web site of said retailer over the Internet to a remote Web site, (Col. 15, lines 37-49, shows that when a request is made, the IPI finding mode and the UPN (i.g. UPC) search mode of the IPI finding and serving subsystem is activated through the IPI website. In this case, the IPI finding and serving subsystem is the remote system since it is associated with the operation of the Web based document server which serves Web pages to clients);

in response to receipt of said request at said remote site, transmitting from said remote site over the Internet to said Web site of said retailer a list of manufacturer incentives/means for transmitting from said remote site over the Internet to said Web site of said retailer a list of manufacturer incentives; (Col. 12, lines 16-20, shows transfer of consumer product related information between the Remote Client Computer and the Web-Based Document Server, *in this case, the retailer website is shown by the Client Computer*, and the remote website is shown by the Web-Based Document Server since it is remote to the Remote Client], w/ Col. 11, lines 37-40, [shows that a central UPC/URL database Subsystem serves the consumer product information to retailers, w/ Col. 13, lines 2-9, where it is also shown that the Web based document server transfers UPC/URLs to the IPD servers, and therefore works in conjunction with the UPC/URL database to serve the consumer product information to retailers, w/ Col. 6, lines 50-58, the list is shown by categorizing and graphically displaying product information which also includes Product Incentives).

in response to receipt of said manufacturers incentives at said Web site of said retailer, transmitting over the Internet to said consumer computer said list of manufacturers incentives/means for transmitting over the Internet to said consumer computer said list of manufacturers incentives, (Col. 11, lines 37-40, shows that a central UPC/URL database Subsystem serves the consumer product information to consumers, w/ Col. 13, lines 2-9, where it is also shown that the Web based document server transfers UPC/URLs to the IPD servers, and

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therefore works in conjunction with the UPC/URL database to serve the consumer product information to the consumers, w/ Col. 6, lines 50-58, the list is shown by categorizing and graphically displaying product information which also includes Product Incentives).

As per claim 24, 36, 48, 49, Perkowski discloses:

transmitting from a consumer computer over the Internet to a Web site of a manufacturer/retailer a request for manufacturer incentives to purchase one of a product and a service offered by said manufacturer/means for transmitting from a consumer computer over the Internet to a Web site of a manufacturer/retailer a request for manufacturer incentives to purchase one of a product and a service offered by said manufacturer, (Col. 11, line 64-Col. 12, line 5, shows a plurality of User (or Client) Computers being connected to the Internet and available to consumers, Manufacturers, and Retailers, w/ Col. 15, lines 1-4, lines 19-27, shows that a consumer makes a request at a client subsystem that is physically hosted at the retailer by way of a three-field browser framework, in this case, both the manufacturer and retailer can be accessed at the retailer site since a three-field Netscape-style display framework is presented for interaction between the consumer and the manufacturer, and the consumer and the retailer);

in response/means for, in response to receipt of a request for manufacturer incentives, transmitting region data from said Web site of said manufacturer over the Internet to a remote Web site/in response to receipt of a request for manufacturer incentives to purchase one of a product and a service offered by a manufacturer

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transmitted from a consumer computer over the Internet, transmitting region data from a Web site of said manufacturer over the Internet to a remote Web site/in response to receiving at a web site of a manufacturer, a request for manufacturer incentives to purchase one of a product and a service offered by a manufacturer transmitted from a consumer computer over the Internet, transmitting region data from a Web site of said manufacturer over the Internet to a remote Web site/in response to receipt of a request for manufacturer incentives to purchase one of a product and a service offered by a manufacturer transmitted from a consumer computer over the Internet to a Web site of a retailer, transmitting said request from said Web site of said retailer over the Internet to a remote Web site, (Col. 11, lines 37-45, shows that consumer product information is stored to (transferred over to) the UPC/URL Database from a remote retailer or consumer, which includes the URLs specifying the location of information resources);

in response to receipt of region data at said manufacturer's Web site, transmitting from said remote Web site to said Web site of said manufacturer at least one manufacturer incentive and at least one name and address of a retailer/means for transmitting from said remote Web site to said Web site of said manufacturer at least one manufacturer incentive and at least one name and address of a retailer/ in response to receipt of said request at said remote site, transmitting from said remote site over the Internet to said Web site of said retailer a list of manufacturer incentives, (Col. 11, lines 34-45, shows the name of the product's manufacturer and URL specifying the location of information resources are served to remote clients, which are retailers, consumers, and manufacturers)

transmitting from said Web site of said manufacturer over the Internet to said consumer computer said at least one manufacturer incentive and said at least one name and address/ in response to receipt of said manufacturers incentives at said Web site of said retailer, transmitting over the Internet to said consumer computer said list of manufacturers incentives, (Col. 12, lines 16-20, shows transfer of consumer product related information between the Remote Client Computer and the Web-Based Document Server, *in this case, the consumer computer is shown by the Client Computer*, and the remote website is shown by the Web-Based Document Server since it is remote to the Remote Client, w/ Col. 11, lines 37-40, shows that a central UPC/URL database Subsystem serves the consumer product information to consumers, where the name of the product's manufacturer and URL specifying the location of information resources are served to remote retailers and consumers and is included in consumer product information, w/ Col. 13, lines 2-9, where it is also shown that the Web based document server transfers UPC/URLs to the IPD servers, and therefore works in conjunction with the UPC/URL database to serve the consumer product information to consumers, w/ Col. 6, lines 50-58, the list is shown by categorizing and graphically displaying product information which also includes Product Incentives, w/ Col. 11, lines 34-45, shows the name of the product's manufacturer and URL specifying the location of information resources are served to remote retailers and consumers).

As per claim 25, 37, Perkowski discloses:

wherein said step of transmitting from said remote site said list further comprises transmitting a link to a Web site of said retailer/wherein said means for transmitting from said remote site said list further comprises means for transmitting a link...(Col. 11, lines 34-45, serving URLs to retailer).

As per claims 26, 30, 38, 42, Perkowski discloses:

determining said at least one manufacturer's incentive and said at least one name and address of a retailer by querying, using said region data, a database from a server of said remote Web site/means for determining...transmitting from the consumer computer over the Internet to the Web site of the retailer region data./means for transmitting...(Col. 22,lines 48-60, URL selection query for product data, Col. 11, lines 34-40, shows that product data includes manufacturer name data).

As per claims 50, 51 Perkowski discloses:

Transmission/Mean for transmitting from a consumer to a retailer website, (Col. 11, line 64-Col. 12, line 5, shows a plurality of User (or Client) Computers being connected to the Internet and available to consumers, Manufacturers, and Retailers, w/ Col. 15, lines 1-4, lines 19-27, shows that a consumer makes a request at a client subsystem that is physically hosted at the retailer by way of a three-field browser framework);

Transmission/Mean for transmitting from the retailer website to a remote website, (Col. 12, lines 16-20, shows transfer of consumer product related information between the Remote Client Computer and the Web-Based Document Server, in this case, the retailer website is shown by the Client Computer, and the remote website is

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shown by the Web-Based Document Server since it is remote to the Remote Client),
and

Transmission/Mean for transmitting from the remote website to the to the
retailer website, of a list of manufacturer incentives, (Col. 11, lines 37-40, shows that a
central UPC/URL database Subsystem serves the consumer product information
to retailers, w/ Col. 13, lines 2-9, where it is also shown that he Web based document
server transfers UPC/URLs to the IPD servers, and therefore works in conjunction with
the UPC/URL database to serve the consumer product information to retailers, w/ Col.
6, lines 50-58, the list is shown by categorizing and graphically displaying product
information which also includes Product Incentives).

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all
obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 27, 39 are rejected under 35 U.S.C. 103(a) as being unpatentable over
Perkowski (US Patent 5,950,173).

As per claim 27, 39, Perkowski discloses:

transmitting from said consumer computer to said Web site of said manufacturer selection data indicating selection of said at least one manufacturer incentive/means for transmitting...(Col. 15, lines 19-44, shows that a consumer makes a request at a client subsystem that is physically hosted at the retailer by way of a three-field browser framework which includes search button);

transmitting from said Web site of said manufacturer to said remote site said selection data/means for transmitting from said Web site...(Col. 15, lines 37-40, IPI finding an serving subsystem is the remote site);

transmitting from said Web site of said manufacturer to said consumer computer details/means for transmitting from said Web site of said manufacturer, (Col. 12, lines 16-20, shows transfer of consumer product related information between the Remote Client Computer and the Web-Based Document Server, *in this case, the consumer computer is shown by the Client Computer*, and the remote website is shown by the Web-Based Document Server since it is remote to the Remote Client, w/ Col. 11, lines 37-40, shows that a central UPC/URL database Subsystem serves the consumer product information to consumers, where the name of the product's manufacturer and URL specifying the location of information resources are served to remote retailers and consumers and is included in consumer product information, w/ Col. 13, lines 2-9, where it is also shown that the Web based document server transfers UPC/URLs to the IPD servers, and therefore works in conjunction with the UPC/URL database to serve

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the consumer product information to consumers, w/ Col. 6, lines 50-58, the list is shown by categorizing and graphically displaying product information which also includes Product Incentives, w/ Col. 11, lines 34-45, shows the name of the product's manufacturer and URL specifying the location of information resources are served to remote retailers and consumers and is included in consumer product information, w/ Col. 13, lines 2-9, where it is also shown that the Web based document server transfers UPC/URLs to the IPD servers, and therefore works in conjunction with the UPC/URL database to serve the consumer product information to consumers, w/ Col. 6, lines 50-58, the list is shown by categorizing and graphically displaying product information which also includes Product Incentives, w/ Col. 11, lines 34-45, shows the name of the product's manufacturer and URL specifying the location of information resources are served to remote retailers and consumers).

The following is obvious with Perkowski:

transmitting from said remote site to said Web site of said manufacturer details of the selected at least one manufacturer incentive/means for transmitting from said remote site...(Col. 15, lines 37-40, obvious that details are transmitted to the manufacturer since the browser ultimately displays Web pages served from the IPD server and associated with the Search mode);

It would have been obvious to one of ordinary skill in the art to transmit from said remote site to said Web site of said manufacturer details of the selected at least one

manufacturer incentive with the motivation ensuring that significant details of manufacturer selection data are sent to the correct location.

8. Claims 29 and 41 are rejected under 35 U.S.C. 103(a) as being unpatentable over Perkowski (US 5,950,173), and further in view of Sloane (US Patent 5,918,211),

As per claims 29, 41, Perkowski fails to disclose transmitting a user identification from said Web site of said retailer over the Internet to said remote Web site in association with said request and determining manufacturer's incentives to transmit from said remote Website to said Web site of said retailer based upon said user identification, but does disclose the transmission of manufacturer's incentives to consumers in Col. 12, lines 16-20.

However, Sloane discloses:

transmitting a user identification from said Web site of said retailer over the Internet to said remote Web site in association with said request/means for transmitting a user identification....determining manufacturer's incentives to transmit from said remote Website to said Web site of said retailer based upon said user identification/means for determining manufacturer's incentives, (Col. 9, lines 52-58, Claim 12, Claim 15, shows usage of consumer identification in conjunction with transmitting consumer product information). Sloane discloses this limitation in an analogous art for the purpose of showing that a consumer identification can affect the transmittal of consumer product information.

It would have been obvious to one of ordinary skill in the art at the time of the

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applicant's invention to transmit a user identification from said Web site of said retailer over the Internet to said remote Web site in association with said request and determining manufacturer's incentives to transmit from said remote Web site to said Web site of said retailer based upon said user identification with the motivation of sending the consumer an incentive which is identified by consumer id.

9. Claims 31 and 43 are rejected under 35 U.S.C. 103(a) as being unpatentable over Perkowski (US 5,950,173), and further in view of Smolen (US Patent 5,915,243).

As per claims 31, 43, Perkowski fails to teach wherein said region data is postal code data, but does disclose region data through URLs in col. 11, lines 42-43.

However Smolen discloses:

wherein said region data is postal code data, (Col. 4, lines 64-67, represented by postal code). Smolen discloses this limitation in an analogous art for the purpose of showing that postal code data can be incorporated into a system for transmitting incentives.

It would have been obvious to one of ordinary skill in the art for the region data to be postal code data in order to determine the location of the retailer versus the location of the user for incentive transmittal purposes.

Conclusion

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Akiba K Robinson-Boyce whose telephone number is

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703-305-1340. The examiner can normally be reached on Monday-Friday, 8:30 am-5pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Tariq Hafiz can be reached on 703-305-9643. The fax phone numbers for the organization where this application or proceeding is assigned are 703-746-7238 [After final communications, labeled "Box AF"], 703-746-7239 [Official Communications], and 703-746-7150 [Informal/Draft Communications, labeled "PROPOSED" or "DRAFT"].

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-305-3900.



A. R.-B.
October 18, 2004



TARIQ R. HAFIZ
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 3600

Advisory Action

Application No.

09/505,632

Applicant(s)

SCROGGIE ET AL.

Examiner

Akiba K Robinson-Boyce

Art Unit

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--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 7/2/04 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

Therefore, further action by the applicant is required to avoid abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

PERIOD FOR REPLY [check either a) or b)]

- a) ☐ The period for reply expires _____ months from the mailing date of the final rejection.
- b) ☒ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection. ONLY CHECK THIS BOX WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1. ☐ A Notice of Appeal was filed on _____. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.
2. ☐ The proposed amendment(s) will not be entered because:
- (a) ☐ they raise new issues that would require further consideration and/or search (see NOTE below);
 - (b) ☐ they raise the issue of new matter (see Note below);
 - (c) ☐ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
 - (d) ☐ they present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: _____.

3. ☐ Applicant's reply has overcome the following rejection(s): _____.
4. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
5. ☒ The a) ☐ affidavit, b) ☐ exhibit, or c) ☒ request for reconsideration has been considered but does NOT place the application in condition for allowance because: See Continuation Sheet.
6. ☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.
7. ☒ For purposes of Appeal, the proposed amendment(s) a) ☐ will not be entered or b) ☒ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

The status of the claim(s) is (or will be) as follows:

Claim(s) allowed: _____.

Claim(s) objected to: _____.

Claim(s) rejected: 24-31, 36-43 and 48-51.

Claim(s) withdrawn from consideration: _____.

8. ☐ The drawing correction filed on _____ is a) ☐ approved or b) ☐ disapproved by the Examiner.
9. ☐ Note the attached Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____.
10. ☐ Other: _____

Continuation of 5. does NOT place the application in condition for allowance because: prosecution has been re-opened for this case and the examiner has cited new art..